

Serial No. 10/786,755

Response to Office Action of March 9, 2006

Date of Response June 9, 2006

REMARKS AND ARGUMENTS

Claim Rejections - Sugimoto reference not prior art

The Examiner has rejected claims 1-4, 8-10, 12-25 and 27-42 under 35 U.S.C. 102(b) as being anticipated by Sugimoto et al. (WO 03/010832) (hereafter "Sugimoto WO") and claims 5, 11, 22 and 43 under 35 U.S.C. 103(a) as being unpatentable over Sugimoto in combination with other references.

Applicant submits that Sugimoto is not prior art under 35 U.S.C. 102(b). The actual reference used by the Examiner is EP 1,418,628 (hereafter "Sugimoto EP") which is from the same patent family as Sugimoto, according to the Examiner. Of the two, Sugimoto WO has an earlier publication date of February 6, 2003. The present application was filed on February 24, 2004, and claims the benefit of Provisional Application Serial No. 60/451,067 which was filed February 26, 2003. (See Application: page 1, paragraph [0001]). The subject matter claimed in Applicant's non-provisional application is fully supported by the disclosure in the provisional application, and thus, the claims embodying that subject matter are entitled to the February 26, 2003, priority date. Because Sugimoto WO was first published less than a year prior to that date, the reference is not prior art under U.S.C. 102(b).

Applicant submits that claims 1-5, 8-25 and 27-43 are otherwise allowable and request a withdrawal of the rejections of those claims.

Serial No. 10/786,755

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Claim Rejections - 35 USC § 102

The Examiner has again rejected claim 1 as well as claims 6 and 7 under 35 U.S.C. 102(b) as being anticipated by Carey et al. (US 6,204,523) (hereafter "Carey"). Applicants disagree with the Examiner's analysis of the prior art.

Applicants believe that Carey does not provide an enabling disclosure with respect to the applicants claimed invention. A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." In re Donohue, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

Applicants submit that the public was not in possession of the claimed invention before the date of the invention. "[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); see also Amgen Inc. v. Chugai Pharms. Co., 927 F.2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed. Cir. 1991); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) ("[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.").

Carey teaches an LED device emitting light in the green-to-near UV wavelength range that is specifically adapted to withstand prolonged exposure to a range of temperatures,

Serial No. 10/786,755

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humidity levels, and UV radiation levels. The invention is not directed toward manipulating the emission spectrum of the device. The Examiner cites the following paragraph in Carey as anticipating all the elements of Applicants' claim 1:

Similarly, particles of light-emitting material, such as phosphor, may be embedded in the optically transmissive cover. Depending on the type of optically transmissive cover used (i.e., the various embodiments discussed above), the particles can be embedded either in the hard shell or in the softer interior silicone material. Responsive to excitation by radiation from the LED die, such particles emit light of a different wavelength from the radiation of the LED die.

The previous paragraph is not sufficient to put the person of reasonable skill in the art in possession of Applicants' invention as described in claim 1. Carey provides no information regarding the how the spectral emission is manipulated or the physical properties of the conversion material (e.g., the distribution of the conversion material around the light source). The person of skill in the art would not be able to obtain the necessary information from Carey to make and use the emitter taught by Applicants' claim 1. Therefore, the Carey reference is non-enabling with respect to claim 1.

For at least the reasons stated above, Applicants submit that claim 1 is allowable and respectfully request the withdrawal of the rejection of the claim.

Serial No. 10/786,755

Response to Office Action of March 9, 2006

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Claims 6 and 7 depend from claim 1 and as such are also allowable. Applicants respectfully request the withdrawal of the rejection these claims as well.

CONCLUSION

Applicant notes that the Examiner has made no comment regarding claim 26. As such, Applicant assumes that claim 26 is allowable unless informed otherwise.

Applicant submits that claims 1-43 are in condition for allowance, and applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



Brian J. Philpott
Attorney for Applicants
Registration No. 58,688

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Koppel, Patrick & Heybl
555 St. Charles Drive, Suite 107
Thousand Oaks, CA 91360
Phone 805 373 0060,
Fax 805 373 0051